

REMARKS

Claims 1-5 and 7-29 are pending and claims 8, 12, 17, 21, and 23-29 have been withdrawn pursuant to a restriction requirement. Claim 1 is rejected under 35 U.S.C. § 112, first and second paragraphs, as failing to comply with the written description requirement and as being indefinite. Claim 7 is objected to under 35 U.S.C. § 112, fourth paragraph, for improperly depending from claim 1. Claims 8 and 22 are objected to for informalities. Claims 1-5, 7, 13-16, 18-20, and 22 are rejected under 35 U.S.C. § 102(b) over Chun (WO 03/050305). Claims 9-11 are rejected under 35 U.S.C. § 103(a) over Chun in view of Liu and Whittier (1995) Genomics 25, 674-681; Watanabe et al. (2001) Journal of Microbiological Methods 44,253-262; and Oberste et al. (1999) Journal Clinical Microbiology 37, 1288-1293. Each of the objections and rejections will be addressed in turn below.

Interview Summary

Applicant thanks Examiners Pande and Strzelecka for the productive telephonic interview conducted with Forrester Liddle, Applicant's representative, on May 31, 2011. Proposed claim amendments were discussed during the interview. Also, the Examiners indicated that the Chun reference should have been characterized as prior art under 35 U.S.C. § 102(e). The contents of the interview are discussed in more detail below.

Amendments to the Claims

Claim 1 has been amended to recite that p represents an integer of 10 to 60, q is at least 3, s represents an integer of 3 to 10, and Y_q consists of deoxyinosine or inosine. This amendment finds basis at, e.g., page 7, lines 10-12, page 8, lines 15-18, page 9, lines 1-3, and page 11, lines 3-9. Claim 1 has also been amended to eliminate the phrase "Y_q is continuously followed by Z_r." Claim 8 has been amended to depend from claim 1. Claims 14 and 17-20 have been amended to depend from claims 8 and 12. Claim 7 has been cancelled. No new matter has been added by these amendments.

Restriction Requirement

As discussed during the telephonic interview, Applicant maintains that the initial requirement for a species election was made in error. Examiners Pande and Strzelecka agreed that the first, second, and third claimed DW-ACP primers are separate components of a single claimed method and, therefore, it was not necessary or proper to require election of a single formula for examination. Consequently, Applicant respectfully requests that the subject matter of dependent claims 8 and 12 be examined.

Rejection under 35 U.S.C. § 112, first paragraph

Claim 1 is rejected as failing to comply with the written description requirement for containing new matter. Claim 1 has been amended to remove the phrase “Y_q is continuously followed by Z_r.” Therefore, this rejection is moot and can be withdrawn.

Rejections under 35 U.S.C. § 112, second paragraph

Claim 1 is rejected as being indefinite for reciting that “the annealing portion of the first DW-ACP is restricted to the portion consisting of said degenerate random nucleotide sequence.” The Office concludes that this statement is inconsistent with the phrase describing Q_s, which “represents a 3' end portion having a hybridizing nucleotide sequence substantially complementary to a site on said unknown nucleotide sequence.” As the Examiners agreed during the interview, the complete phrase objected to by the Office recites “the annealing portion of the first DW-ACP is restricted to the portion consisting of said degenerate random nucleotide sequence and hybridizing nucleotide sequence at the first annealing temperature.” Therefore, the “annealing portion” includes both the degenerate “random nucleotide sequence” (Z_r) and the “hybridizing nucleotide sequence” (Q_s). Because Q_s is included in the “annealing portion,” the 3' end of the primer is able to anneal to the unknown sequence. Consequently, this rejection can be withdrawn.

Claim 1 is also rejected as indefinite because p, q, and s are not defined and, therefore, could equal zero. Solely to expedite prosecution, claim 1 has been amended to recite specific integer ranges for p, q, and s, and, therefore, this rejection can be withdrawn.

Claim Objections

Claim 7 is objected to under 35 U.S.C. § 112, fourth paragraph, for improperly depending from claim 1. Claim 7 has been cancelled solely to expedite prosecution. This objection can, therefore, be withdrawn.

Claim 8 is objected to for depending from a cancelled claim. Claim 8 has been amended to depend from claim 1 and, therefore, this objection can be withdrawn.

Claim 22 is objected to for being in improper multiply dependent form. Claim 22 has been amended to depend only from claim 8 and recite only “w.” Therefore, this objection can be withdrawn.

Rejections under 35 U.S.C. § 102(b)

Claims 1-5, 7, 13-16, 18-20, and 22 were rejected as being anticipated by Chun. As discussed with the Examiners during the telephonic interview, Chun does not qualify as prior art under 35 U.S.C. § 102(b), because it published less than one year prior to the filing date of the earliest priority date of the present application. Chun published June 19, 2003 and the present application is a national stage application of PCT Application No. PCT/KR2003/002407, which was filed November 11, 2003. Furthermore, Chun does not qualify as prior art under 35 U.S.C. § 102(a) or 102(e). With respect to 35 U.S.C. § 102(a), the M.P.E.P. states “[a] *prima facie* case is made out under 35 U.S.C. 102(a) if, within 1 year of the filing date, the invention, or an obvious variant thereof, is described in a “printed publication” whose authorship differs in any way from the inventive entity unless it is stated within the publication itself that the publication is describing the applicant’s work” (§ 2132.01, emphasis added). 35 U.S.C. § 102(e) states that a published application is prior art if it was filed “by another” prior to Applicant’s invention. The M.P.E.P. states that “[a]nother” means other than applicants, *In re Land*, 368 F.2d 866, 151 USPQ 621 (CCPA 1966), in other words, a different inventive entity. The inventive entity is different if not all inventors are the same” (§ 2136.04). Both the present application and Chun list Jong-Yoon Chun as the sole inventor. Therefore, the inventive entity of the present application is identical to the inventive entity of Chun. Consequently, Chun is not “by others” under 35 U.S.C. § 102(a) or “by another” under 35 U.S.C. § 102(e). Because the inventive entities are the same, Applicant submits that no further evidence is necessary remove Chun as prior art under 35 U.S.C. § 102(a) or (e). Consequently, this rejection for anticipation can be withdrawn.

Rejection under 35 U.S.C. § 103(a)

Claims 9-11 are rejected under 35 U.S.C. § 103(a) over Chun in view of Liu and Whittier; Watanabe; and Oberste. As stated above, Chun is not prior art to the present application. Therefore, the rejection for obviousness over Chun should be withdrawn.

Information Disclosure Statement

Applicant finally notes that an Information Disclosure Statement and Form PTO 1449 were filed on April 1, 2009, and that an initialed copy of the Form PTO 1449 has not been returned. Applicant requests that such a copy be returned with the next Action.

CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and the timely allowance of the currently amended claims.

Transmitted herewith is a petition to extend the period for replying for three months, to and including June 1, 2011.

If there are any charges or any credits associated with this filing, please apply them to Deposit Account No. 03-2095.

Respectfully submitted,

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Susan M. Michaud
Susan M. Michaud, Ph.D.
Reg. No. 42,885

Clark & Elbing LLP
101 Federal Street
Boston, MA 02110
Telephone: 617-428-0200
Facsimile: 617-428-7045